

Notice of Allowability

Application No.

09/782,855

Examiner

Raymond Covington

Applicant(s)

PARKER ET AL.

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 7/19/04, 11/1/04.
2. ☒ The allowed claim(s) is/are 1-9, 19, 22-37 and 39-41.
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

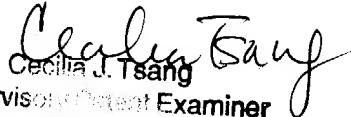
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413), Paper No./Mail Date 9/28/04
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____


Cecilia J. Tsang
Supervisory Patent Examiner
Technology Center 1600

EXAMINER'S AMENDMENT

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Nicole Beeler on September 28, 2004.

The application has been amended as follows:

Claim 38 has been canceled.

Claim 38 was canceled without prejudice to applicants' right to file an application drawn to the canceled subject matter. It is noted that corresponding claim 21 has been canceled by applicants' amendment of November 1, 2004.

REASONS FOR ALLOWANCE

The following is an examiner's statement of reasons for allowance:

Upon reconsideration the rejection under 35 USC 103 has been withdrawn. The invention, as presently recited in the claims, differs patentably from the Cragoe Jr. et al, US 4,731,471, and Conn et al, US 4,704,472, references as well as the prior art as a whole in that the 4 position R³ substituent is not present in the prior art compounds but is required by applicants' invention. Neither does the

prior art teach or suggest a reason to modify any reference to obtain the claimed invention.

Also upon reconsideration in light of applicants' amendment of November 1, 2004, the rejection under 35 USC 112 has been withdrawn. The nexus between estrogen receptor modulation and the treatments recited by the claims is supported by numerous references in the prior art.

For example, the utility of SERMs for the treatment of breast, uterine or prostate cancer is known in the literature, see T.J. Powles, "Breast cancer prevention," *Oncologist* 2002; 7(1):60-4; Park, W.C. and Jordan, V.C., "Selective estrogen receptor modulators (SERMS) and their roles in breast cancer prevention." *Trends Mol Med.* 2002 Feb;8(2):82-8; Wolff, A.C. et al., "Use of SERMS for the adjuvant therapy of early-stage breast cancer," *Ann N Y Acad Sci.*

Accordingly, claims 1-9, 19, 22-37 and 39-41 are allowed.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raymond Covington whose telephone number is (571) 272-0681. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, C. Tsang can be reached on (571) 272-0562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Raymond Covington
Examiner
Art Unit 1625


RKC


Cecilia J. Tsang
Supervisory Patent Examiner
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